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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Inventors : Brian R. McCarthy et al.
Filed : June 1, 2001
TC/A.U. : 1794
Examiner : Alicia Ann Chevalier
Docket No. : A019-P08127US (5038 old)
Avery Ref : 2991-US
Customer No. : 33356
Entitled : **SHEET OF PRINTABLE BUSINESS CARDS**

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. §§ 1.181 AND 1.104(c)(2)

Dear Sir:

Applicant hereby petitions the Director under 37 C.F.R. § 1.181 to instruct the Examiner to issue an action that presents the rejections in a manner that complies with 37 C.F.R. § 1.104(c)(2) and with MPEP 707.07(f).

Background

The rejections of independent claims 314, 363, 387 and 413 issuing in the Final Rejection dated May 28, 2008 (hereinafter "Final Rejection") and the rejections of dependent claim 332 (whose features were incorporated into its independent claim 314) and independent claims 363, 387 and 413 issuing in the Office Action dated November 1, 2007 (hereinafter "Non-Final Office Action") were legally incomplete and deficient. These deficiencies were clearly explained in Applicant's Amendment After Final Rejection dated September 15, 2008 (hereinafter "Amendment After Final Rejection") and in Applicant's Amendment dated February 21, 2008 (hereinafter "2/21/2008 Amendment"). In both of these amendments Applicant, in addition to responding as best as

Applicant could to the incomplete rejections, carefully pointed out these deficiencies and requested that the Examiner issue additional papers which corrected these deficiencies and which responded to Applicant's remarks and arguments. The Examiner did not issue such papers correcting the deficiencies and responding to Applicant's arguments, but rather ignored them.

In response to the Amendment After Final Rejection, the Examiner issued a First Advisory Action on September 24, 2008. The First Advisory Action did not indicate whether the Amendment After Final Rejection would be entered. Thus, Applicant requested a corrected Second Advisory Action. Applicant, upon receipt of the incomplete First Advisory Action and before the issuance of the Second Advisory Action, reminded the Examiner in an e-mail dated September 30, 2008 that issuance of a new action or supplemental paper correcting the deficient and incomplete rejections had been requested and was in order. The Examiner did not issue such paper with her Second Advisory Action on October 14, 2008.

Thus, the Examiner has ignored Applicant's request for corrected or withdrawn rejections in the Amendment After Final Rejection, the 2/21/2008 Amendment and the September 30 e-mail. Hence, Applicant has absolutely no reason to expect that the Examiner will issue corrected or withdrawn rejections with her next action. In fact, Applicant expects the Examiner will only say that all of the rejections are repeated for the same reasons as set forth in her Final Rejection and without any remarks responding to Applicant's comments and requests.

Accordingly, Applicant files the subject petition to have the Director instruct the Examiner to issue as her next Office Action, an action which corrects the subject rejections if she repeats them or makes similar rejections.

With the issuance of corrected and complete rejections, Applicant can prepare and file appropriate responses. If Applicant's responses do not convince the Examiner to withdraw her rejections, then Applicant can file a Notice of Appeal and an appropriate Appeal Brief. Applicant chose to file a Request for Continued Examination on October 28, 2008 (hereinafter "RCE") and the present Petition in response to the Final Rejection instead of filing an appeal because of the deficient and incomplete status of the rejections in the Final Rejection.

Statement of Facts

The present application was filed on June 1, 2001, more than seven years ago. Office Actions issued on December 2, 2002, July 28, 2003, January 15, 2004, September 23, 2004, February 22, 2005, January 12, 2006, and August 23, 2006, and Applicant filed responses to each of them.

On September 14, 2006, as part of the response to the August 23, 2006 Office Action, Applicant filed a Declaration of Dr. Ronald Ugolick (hereinafter "Dr. Ugolick's Declaration"), the entire contents of which are hereby incorporated by reference. A Final Office Action issued on December 4, 2006 (hereinafter "12/4/06 Final Office Action"), and in response thereto Applicant filed a Pre-Brief Appeal Conference Request on May 31, 2007. On July 24, 2007, the Patent Office issued a Pre-Brief Appeal Conference Decision withdrawing the rejections in that Final Office Action.

The Non-Final Office Action then issued in which the Examiner for the first time used U.S. Patent 5,462,488 (McKillip) as a reference in rejecting the claims. Applicant filed the 2/21/2008 Amendment in response thereto, and the Final Rejection then issued. Since the rejections in the Final Rejection were deficient and incomplete as explained in detail elsewhere in this Petition, Applicant filed the RCE so that the present Petition could be filed. Together with the RCE, Applicant filed an Amendment making the amendments to the specification and claims which the Examiner indicated in her Second Advisory Action would be entered in response to the Amendment After Final and also adding one additional dependent claim. That Amendment essentially repeated the reasons why the rejections as set forth in the Amendment After Final (and in the 2/21/2008 Amendment) were incomplete and deficient. An Information Disclosure Statement was also filed with the RCE.

The Prior Rejections Were Defective for Failing to Comply with 37 C.F.R. § 1.104(c)(2)

The obviousness rejections in the Non-Final Office Action and the Final Rejection were defective because the pertinence of the McKillip primary reference was not apparent and was not clearly explained for each rejected claim. Clear explanations have been requested by Applicant.

The standard for explanations of rejections under 35 U.S.C. §§ 102 and 103 is set forth in 37 C.F.R. § 1.104(c)(2) as follows:

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (Emphasis Added.)

Final Rejection Was Defective for Failing to Comply with MPEP 707.07(f)

The Examiner in the Final Rejection essentially repeated the rejections in the Non-Final Office Action. She therein did not address all of Applicant's arguments in the 2/21/2008 Amendment. The Final Rejection thus did not comply with MPEP 707.07(f), and the action is thereby defective.

MPEP 707.07(f) states "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." (Emphasis added.) And referring to ¶ 7.37, the Examiner's response should be: "Applicant's arguments filed [The examiner **must** address all arguments which have not already been responded to in the statement of the rejection.] have been fully considered but they are not persuasive [and **provide explanation** as to non-persuasiveness]." (Emphasis Added.)

Detailed Discussions of Deficiencies of Rejections in Each of the Independent Claims

Set forth below are detailed discussions of each of the independent claims, where there is support for them, the deficiencies of the rejections of those claims and when and where Applicant pointed out these deficiencies in his responses.

Claim 314

Dependent claim 332 was rejected in the Non-Final Office Action. Dependent claim 332 read: "332. The sheet of claim 314 wherein the ultraremovable adhesive provides only partial

contact with the cardstock sheet construction and the partial contact prevents the ultraremovable adhesive from becoming permanent over time.” The only explanation of this rejection in the Non-Final Office Action was the following sentence on page five: “[t]he ultraremovable adhesive is deemed to be a suspension polymer ultraremovable adhesive with a primer coat between the ultraremovable adhesive and the liner sheet [McKillip] col. 7, lines 35-47.” That section of McKillip reads as follows:

Adhesive means 28 (FIG. 4), which is operably applied to upper surface 37 of first layer of material 22, is preferably a pressure sensitive adhesive, such as an acrylic based permanent adhesive or a removable rubber based adhesive--although other types of conventional adhesives are also contemplated for use. Notably, such pressure sensitive adhesives substantially eliminate the migration thereof to bottom surface 45 (FIG. 6) of card member, such as card member 46 (FIG. 7), upon removal of the card member therefrom. Accordingly, the bottom surface of the card member will not bear any substantial tackiness--as would otherwise occur with the use of various other types of adhesives.

In other words, the Non-Final Office Action provided no reasons as to how or where McKillip disclosed (a) an ultraremovable adhesive and (b) particularly one providing “only partial contact ... preventing the ultraremovable adhesive from becoming permanent over time,” as set forth in dependent claim 332.

Independent claim 314 was amended in the 2/21/2008 Amendment, to add the feature from dependent claim 332, namely that “the ultraremovable adhesive providing only partial contact with the cardstock sheet construction and the partial contact preventing the ultraremovable adhesive from becoming permanent over time.” (Emphasis added.) (And dependent claim 332 was accordingly cancelled.)

Support for this feature is found for example in paragraph [0023] of the subject application as filed: “... conventional adhesives provide complete contact with a substrate while ultraremovable adhesive provide partial contact. This limited contact area is what prevents an ultraremovable adhesive from becoming permanent, over time.”

The Remarks in the 2/21/2008 Amendment specifically pointed out that McKillip did not disclose any of the limitations added to claim 314 from dependent claim 332. See pages 22 and 23 of that Amendment. Referring thereto, Applicant specifically pointed out, for example, that McKillip does not disclose an “ultraremovable” adhesive, referencing Dr. Ugolick’s Declaration.

In paragraph 4 of the Final Rejection, the Examiner said only that: “[t]he 35 U.S.C. §103 rejection over McKillip (U.S. Patent 5,462,488) is repeated for reasons previously made of record in the office action mailed November 1, 2007, pages 3-5, paragraph #6.” (Emphasis added.) In paragraph 11 at the top of page 3, the Examiner said: “Applicant’s arguments in the response filed February 21, 2008 regarding the limitation ‘ultraremovable adhesive’ of record have been carefully considered but are deemed unpersuasive. Applicant argues that the adhesive in McKillips is not a (*sic* --an) ‘ultraremovable’ asset (*sic* --as set) forth in Dr. Ugolisk’s (*sic*--Ugolick’s) Declaration filed on September 14, 2006. The declaration by Dr. Ugolick is unpersuasive for the responses proved (*sic* --provided) in the office action mailed December 4, 2006.”

Referring to the above-mentioned 12/4/06 Final Office Action and particularly paragraph #5 thereof, the Examiner discussed the Dr. Ugolick Declaration. Her discussion, however, was deficient and inapplicable for the following reasons. (1) In interpreting the use of “ultraremovable adhesive” in the claims she misread the claims as calling for the back surface of the ultraremovable adhesive instead of the business cards as being non-tacky. This misinterpretation infected her entire argument.

This misinterpretation was noted and her rejections were accordingly withdrawn by the Pre-Appeal Brief panel in its Decision dated July 25, 2007. (2) The Declaration did not address whether the feature at issue was disclosed by McKillip. In fact, McKillip was not even of record at the time the Declaration was filed or when the 12/4/06 Final Office Action issued. (3) The Declaration being an opinion by one skilled in the art is evidence in itself, and the Examiner did not treat it as such.

In the Amendment After Final Rejection, Applicant pointed out that the rejection of claim 314 was deficient because it did not address Applicant’s remarks responding to the Examiner’s prior rejection of claim 314 and because it did not explain where McKillip taught the feature at issue. Applicant requested a supplemental paper be issued to remedy these deficiencies. Applicant

repeated this request in the e-mail dated September 30, 2008 to the Examiner. No supplemental papers were issued and Applicant's requests were not even acknowledged by the Examiner.

Claim 339

Independent claim 339 includes the feature that the ultraremovable adhesive is a "suspension-polymer adhesive." Support for this feature is found in paragraph [0104] for example.

In the Final Rejection, claim 339 was rejected as follows: "4. The 35 U.S.C. § 103 rejection over McKillip (US Patent 5,462,488) is repeated for reasons previously made of record in the office action mailed November 1, 2007, pages 3-5, paragraph #6." The Examiner also said on page 3: "11. Applicant's arguments in the response filed February 21, 2008 regarding the limitation 'ultraremovable adhesive' of record have been carefully considered but are deemed unpersuasive. Applicant argues that the adhesive in McKillips is not a (*sic* -- an) 'ultraremovable' asset (*sic* -- as set) forth in Dr. Ugolisk's (*sic* -- Ugolick's) Declaration filed on September 14, 2006. The declaration by Dr. Ugolick is unpersuasive for the responses proved (*sic* -- provided) in the office action mailed December 4, 2006."

In the rejections of these claims on page 5 of the Non-Final Office Action, it states that "[t]he ultraremovable adhesive is deemed to be a suspension polymer ultraremovable adhesive with a primer coat between the ultraremovable adhesive and the liner sheet (*col. 7, lines 35-47*)."

(Emphasis Added.) No explanations were provided in the Non-Final Office Action or the Final Rejection (a) as to why the McKillip adhesive was construed ("deemed") to be an "ultraremovable" adhesive or (b) as to why the McKillip adhesive was deemed to be a "suspension polymer" ultraremovable adhesive.

McKillip col. 7, lines 35-47, does not disclose that the "adhesive means 28" is an ultraremovable adhesive as would be understood by one skilled in the art from the present application and as has previously been discussed at length by Applicant in prior responses in this application. In particular, the meaning of "ultraremovable adhesive" is set forth in Dr. Ugolick's Declaration. An ultraremovable adhesive is a removable adhesive that does not become permanent over time. (See paragraph [0023], "[a] fundamental difference is that conventional adhesives

provide complete contact with a substrate while ultraremovable adhesive provide partial contact. This limited contact area is what prevents an ultraremovable adhesive from becoming permanent, over time.)” (Emphasis added.)

In contrast, McKillip says that the adhesive means 28 is “preferably a pressure sensitive adhesive, such as acrylic based permanent adhesive or a removable rubber based adhesive – although other types of conventional adhesives are also contemplated for use.” As would be apparent to those skilled in the art and as Applicant continues to contend, these are not “suspension-polymer ultraremovable adhesives.” Furthermore, McKillip’s acrylic-based permanent adhesive is a permanent adhesive and not one which does not become permanent, and the “removable rubber based adhesive” is not a suspension polymer. Additionally, an ultraremovable adhesive is not a “conventional adhesive.”

First, Applicant is not aware of any law or Patent Office practice which allows an Examiner to “deem” a prior art reference to be something which it is not. Second, Applicant on pages 22 and 23 of its earlier Amendment specifically pointed out that McKillip does not disclose a “suspension-polymer ultraremovable adhesive.” Third, the Examiner in the Final Rejection did not respond to or comment on or even acknowledge Applicant’s arguments.

Claims 363 and 387

Independent claim 363 includes “a primer coat between the ultraremovable adhesive and the liner sheet,” and independent claim 387 includes that the liner sheet is “a primer-coated liner sheet.” (Emphasis added.) These two claims were rejected in the Non-Final Office Action as follows: “4. The 35 U.S.C. § 103 rejection over Mckillip (*sic* -- McKillip) (US Patent No. 5,462,488) is repeated for reasons previously made of record in the office action mailed November 1, 2007, pages 3-5, paragraph #6.” That section of the Non-Final Office Action states with reference to McKillip: “[t]he ultraremovable adhesive is deemed to be a suspension polymer ultraremovable adhesive with a primer coat between the ultraremovable adhesive and the liner sheet (*col. 7, lines 35-47*).”).” And that section of McKillip reads as follows:

Adhesive means 28 (FIG. 4), which is operably applied to upper surface 37 of first layer of material 22, is preferably a pressure sensitive adhesive, such as an acrylic based permanent adhesive or a removable rubber based adhesive--although other types of conventional adhesives are also contemplated for use. Notably, such pressure sensitive adhesives substantially eliminate the migration thereof to bottom surface 45 (FIG. 6) of card member, such as card member 46 (FIG. 7), upon removal of the card member therefrom. Accordingly, the bottom surface of the card member will not bear any substantial tackiness--as would otherwise occur with the use of various other types of adhesives.

Specifically, McKillip nowhere mentions, discloses or suggests a primer coat between the adhesive 28 and the "liner sheet" 22. As an example, the words "primer" or "primer-coated" are not even used in McKillip. Rather, the adhesive is applied directly to the upper surface 37 of the "liner sheet" 22, as disclosed in col. 7, lines 35-47, and as shown in FIGS. 4 and 6.

Applicant specifically pointed this out to the Examiner at the bottom of page 23 of Applicant's 2/21/2008 Amendment and on page 23 of the Amendment After Final Rejection.

Accordingly, the Final Rejection does not state where McKillip discloses this "primer coat" or this "primer-coated" liner sheet, that McKillip has this primer coat or this primer-coated liner sheet or where there was a suggestion in the prior art for adding this primer coat or this primer-coated liner sheet to McKillip or even acknowledge Applicant's remarks in the 2/21/2008 Amendment.

Claim 413

Claim 413 includes "a weakened fold line in the cardstock sheet construction and across the one of the at least one printable and foldable card." (Emphasis added.) It further states that "the separate printed and foldable card being foldable on the fold line." (And dependent claim 414 says that this "fold line is a score line.") Support for the weakened fold line is found in the Abstract, paragraphs [0115] and [0126] and original claims 38, 39 and 65, for example.

In rejecting the claim in the Non-Final Office Action over McKillip, the Examiner did not point out where such a fold line is disclosed, taught or suggested in the prior art. She merely stated that "[t]he card is deemed capable of being folded." In response to this rejection in the 2/21/2008

Amendment, Applicant said that the “Office Action does not describe where McKillip discloses this weakened fold line across the card, but merely says near the bottom of page 4 that the ‘card is deemed capable of being folded.’ Thus, withdrawal of the rejection of claim 413 is in order.”

The Examiner did not respond to Applicant’s response or further explain her rejection in her Final Rejection. She simply said that the rejection was repeated for “reasons previously made of record in the office action mailed November 1, 2007.”

In Applicant’s Amendment After Final Rejection, Applicant stated that the rejection of independent claim 413 was defective, and the “final Office Action does not state where McKillip discloses this ‘weakened fold line,” that McKillip has this weakened fold line or where there was a suggestion for adding this weakened fold line.” Applicant further requested that a new Office Action issue fully explaining this rejection. The Examiner did not further explain this rejection in a new Office Action or in the incomplete First Advisory Action dated September 24, 2008. This request was repeated in an e-mail to the Examiner dated September 30, 2008. The Examiner did not provide any further explanation or address the issue in her Second Advisory Action dated October 14, 2008.

Applicant’s Amendment dated October 28, 2008 says that the Final Rejection does not state where McKillip discloses this “weakened fold line,” that McKillip has this weakened fold line or where there was a suggestion for adding this weakened fold line to McKillip.

Dependent Claims

The subject Petition also relates to the following dependent claims as they include language corresponding to or similar to respective ones of the above-discussed independent claims. Dependent claims 356, 379, 402, and 432 include the same or similar language as independent claim 314. Dependent claims 325, 349, 365, 372, 389, 395, 418 and 425 include the same or similar language as independent claim 339. Dependent claims 317, 318, 320, 341, 342, 344, 419, 420 and 422 include the same or similar language as independent claim 363 and/or 387. Dependent claim 414 includes the similar language as independent claim 413.

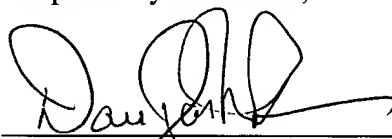
Conclusion

In view of the above, it is respectfully submitted that granting of this Petition at an early date is in order and that the Director thereby instruct the Examiner to issue as her next Office Action, an action which corrects and explains the subject rejections if she repeats them or makes similar rejections.

The requisite fee of \$400 for this petition is submitted herewith by credit card payment authorization form.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 50-3456. Should any such fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,



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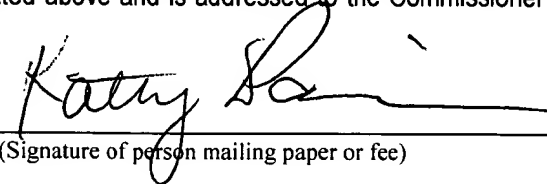
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